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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/506,901	09/07/2004	Martin Wolf	(B)SP 5178 US	6669

7590 04/06/2005  
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EXAMINER

CONSILVIO, MARK J

ART UNIT PAPER NUMBER

2872

DATE MAILED: 04/06/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/506,901

Applicant(s)

WOLF, MARTIN

Examiner

Mark Consilvio

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-5 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-5 is/are rejected.
- 7) ☒ Claim(s) 6 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 07 September 2004 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.  
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948)                                    | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date ____. | 6) <input type="checkbox"/> Other: ____.  |

## DETAILED ACTION

### *Priority*

Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-(d), which papers have been placed of record in the file.

### *Drawings*

The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the connecting line of claim 2 and the conic cross-section of claim 3 must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the

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applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

### *Specification*

The specification is objected to as failing to provide proper antecedent basis for the claimed subject matter. See 37 CFR 1.75(d)(1) and MPEP § 608.01(o). Correction of the following is required: Neither the cross-section as pertaining to a conic section of claim 3 nor the connecting line of claim 2 have been described.

The disclosure is objected to because of the following informalities: The specification may not refer to a particular claim of the disclosure. This occurs on p. 1, lines 4-5 and p. 3, line 14.

Appropriate correction is required.

### *Claim Objections*

Claim 2 is objected to because of the following informalities: There is no proper antecedent basis for “the connecting line” as recited in claim 2. Appropriate correction is required.

### *Claim Rejections - 35 USC § 112*

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 2 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant

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regards as the invention. It is unclear how the section can have a curvature in the direction of a connecting line. Therefore, the metes and bounds of the claim are ambiguous and unclear. Accordingly, claim 2 has not been further examined on its merits.

Claim 3 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. It is unclear how the curvature can have a cross-section that is a conic section since the curvature has not been disclosed as an element with a cross-section and, further, since an infinite number of cross-sections might be taken. Therefore, the metes and bounds of the claim are ambiguous and unclear. Accordingly, claim 3 has not been further examined on its merits.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claim 1 is rejected under 35 U.S.C. 102(b) as being anticipated by Copeland (US Patent No. 2,581,000).

Copeland discloses a device for optically capturing objects, comprising a support surface (18, 19) on which an object (20) can be placed, a light source (e.g. 11, 36, 37) which is provided for emitting illuminating beams in the direction of the support surface (18, 19) and which, in a first position, is arranged relative to the support surface (18, 19),

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and a capturing means (observer eye) which is provided for capturing the positioned object and which, in a second position, is arranged relative to the support surface (18, 19), characterized in that the support surface (18, 19) has a section (e.g. 38, 39 or see col. 3, 4-7) which is provided with a curvature determined by the two positions and which is arranged in such a way that the illuminating beams are reflected by the section in the direction of the capturing means substantially only in a diffuse manner (fig. 1).

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claim 1 is rejected under 35 U.S.C. 103(a) as being unpatentable over Arimura (US Patent No. 4,236,781).

With respect to claim 1, Arimura discloses a for optically capturing objects, comprising a support surface (22) on which an object can be placed, a light source (34) which is provided for emitting illuminating beams in the direction of the support surface (22) and which, in a first position, is arranged relative to the support surface (22), and a capturing means (32) which is provided for capturing the positioned object – and optionally for converting the image of the captured object into electrical signals – and which, in a second position, is arranged relative to the support surface (22). Arimura discloses a section (37) which is provided with an infinite curvature determined by the two positions and which is arranged in such a way that the illuminating beams are

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reflected by the section (37) in the direction of the capturing means (32) substantially only in a diffuse manner (figs. 1 and 3). Arimura is silent to the support surface having the section and the curvature of the section. At the time the invention was made, it would have been obvious to a person of ordinary skill in the art to modify the teachings of Arimura and place the diffuser section with the support surface to free it from possible vibrations from the bonding machine. Further, one of ordinary skill in the art would understand that the section would desirably have a curvature to properly diffuse the incident light.

Claims 1, 4, and 5 are rejected under 35 U.S.C. 103(a) as being unpatentable over Roy et al. (US Patent No. 5,774,263) in view of Inaba (US Patent No. 5,947,575).

Roy et al. discloses a device for optically capturing objects, comprising a support surface (1) on which an object (2) can be placed, a light source (not shown) which is provided for emitting illuminating beams in the direction of the support surface (1) and which, in a first position, is arranged relative to the support surface (1), and a capturing means (observer eye) which is provided for capturing the positioned object and which, in a second position, is arranged relative to the support surface (1), characterized in that the support surface (1) has a section (16) which is provided with a curvature determined by the two positions for diffusing illuminating beams in the direction of the image capture means (figs. 1 and 2). Roy et al. does not expressly disclose the section is arranged in such a way that the illuminating beams are reflected by the section in the direction of the capturing means substantially only in a diffuse manner. Inaba teaches a similar stereo slide viewer with an internal illumination source (13) (as opposed to the external source

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of Roy et al.) and a section (12) for reflecting the illumination beams in the direction of the capturing means in a diffuse manner. At the time the invention was made, it would have been obvious to a person of ordinary skill in the art to combine the teachings of Roy et al. and Inaba to replace the illumination system of Roy et al. with the illumination system of Inaba. One would have been motivated to do this to free the viewer from dependency on ambient light allowing operation in poorly lit locations.

With respect to claim 4, Roy et al. teaches a back-lit, discrete slide capturing region (12) having a mechanical, point-discrete positioning aid (50) for the accurate positioning of at least one first slide (34) is coordinated with the support surface (1) (fig. 3).

With respect to claim 5, Roy et al. teaches a back-lit preview region (12) is provided which is adjacent to the slide capturing region (10) and with which a mechanical, line-discrete positioning aid (88) for positioning at least one further slide (36) on a line is coordinated (fig. 3).

#### *Allowable Subject Matter*

Claim 6 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

The following is a statement of reasons for the indication of allowable subject matter: Though the prior art discloses or suggests all the limitations of claims 1, 4, and 5, the prior art of record fails to teach or suggest the aforementioned combination further comprising the capturing means is rotatable relative to the support surface and the



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capturing means can be repetitively oriented with the discrete slide capturing region by means of a locking element.

### *Conclusion*

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mark Consilvio whose telephone number is (571) 272-2453. The examiner can normally be reached on Monday thru Friday, 8:30 am to 5:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Drew Dunn can be reached on (571) 272-2312. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



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